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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,582	03/04/2002	Guixue Yu	HA0768 NP	5031

23914 7590 02/18/2004

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EXAMINER
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CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 10/090,582	<b>Applicant(s)</b> YU ET AL.	
	<b>Examiner</b> Celia Chang	<b>Art Unit</b> 1625	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED \_\_\_\_\_ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 17.


Claim(s) rejected: 1,3-8,11-16 and 18-22.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.

10. ☒ Other: PTO-892

  
**CEILA CHANG**  
**PRIMARY EXAMINER**  
**GROUP 1200**

Art Unit: 1625

*ATTACHMENT TO ADVISORY*

Amendment and response filed by applicants in Paper No. 10, dated Jan. 28, 2004 will not be entered for the following reason:

1. Please note that in the restriction/election of the first office action dated May 7, 2003 it has been clearly delineated that the election was group II, claim 2 and claims 16-17 species of compounds and also applicants were informed that :

“Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.”

In applicants' Sept. 8, 2003 response, applicants affirms the election of “compounds of claims 16-17” no traversal was made or reason was given with respect to the elected species of compounds. Therefore, applicants can not change their mind by demanding that “*applicants expected the search/examination to have been extended.....*” Please note that if no species of spiro compound was “disclosed” in the specification, an election or traversal that such is within the elected species lacks descriptive support.

2. In addition, the newly amended claims without canceling the spiro-compounds would constitute double patenting over the copending claims of applicants SN 10/090,288 and 10/696,761 wherein both nonspiro and spiro compounds are claimed. Therefore, new issues must be considered.

3. Further, a sample search of the spiro compounds (not complete search) indicated that the spiro compounds is not novel over Charkravarty et al. US 5,804,578 and having growth hormone releasing utility, thus, supporting the propriety of restriction i.e. independent structure and distinct utility between spiro and non-spiro core. Such new search and new issue must be considered.

  
**CEIL CHANG**  
**PRIMARY EXAMINER**  
**GROUP 1200**